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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,266	07/24/2001	James E. Fleming	390054.402	4134

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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC  
701 FIFTH AVE  
SUITE 6300  
SEATTLE, WA 98104-7092

EXAMINER

GABEL, GAIENE

ART UNIT PAPER NUMBER

1641

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO/ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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040605

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

Attached, hereto, is a notice of non-responsive amendment.

***Non-Responsive Amendment***

1. The reply filed on 1/20/05 is not fully responsive to the prior Office Action because claims have been amended to encompass originally non-elected claims. Specifically, originally elected claims 9-24 and 27-28 are drawn to method of detecting viable cells (see below), while originally non-elected claims 1-8, 25, 26, and 29-32 are drawn to device and method of quantitating viable cells and total populations of cells and correlating values therebetween (see below). Accordingly, it has been determined that claims 34-40, as amended, are directed to a new invention that is also otherwise encompassed within the subject matter of non-elected Group I, that is independent or distinct from the original elected claimed invention encompassing the subject matter of Group II, that is currently under prosecution.

2. Applicant contends that the restriction requirement dated 9/30/2002 classified three invention groups, Group II of which was the group elected by Applicant for continued prosecution as indicated in the Response dated 12/19/2002, which consists of claims 9-24, 27, and 28, drawn to method of quantitating total populations and live cells and kit therefor. Group I, which was not elected by Applicant for prosecution in the present application, consists of claims 1-8, 25, 26, and 29-32, drawn to method for determining viability of cells and kit therefor. According to Applicant, at no time has the Applicant change this election.

In response, based upon inspection of the original claims, it appears that restriction requirement dated 9/30/2002 set forth by Examiner, whilst properly and correctly grouped, had a typographic error which incorrectly described the subject matter encompassed by each set of claims. This error becomes clear upon inspection and reading of what is actually recited in each set of claims.

A) Elected method claims of Group II under prosecution as originally filed are reiterated herein as follows:

Claim 9. A method for detecting viable cells, comprising providing a sample containing cells, contacting said sample with a dye that diffuses or is transported into said cells and wherein said dye is detectably altered by enzymatic activity of a viable cell, thereby detecting viable cells in a sample.

Claim 17. A method for quantitating viable cells in a sample, comprising providing a sample containing said cells, contacting said cells with molecule or dye that is detectably altered by enzymatic activity of a viable cell, detecting enzymatically altered dye or molecule, thereby detecting the number of viable cells in said sample and obtaining a value therefrom and correlating the detected viable cell value with a standard value, thereby quantitating the viable cells in said sample.

A) Non-elected method claims of Group I as originally filed and withdrawn during prosecution are reiterated herein as follows:

Claim 1. A method for determining the percent viability of cells in a sample, comprising providing a sample containing said cells, detecting the total cell count, contacting said cells with molecule or dye that is detectably altered by enzymatic activity of a viable cell, detecting enzymatically altered dye or molecule, thereby detecting the number of viable cells and comparing the number of total cells with the number of viable cells thereby determining the percent viability.

Claim 25. A method of quantitating total and live cells in a sample, comprising measuring total fluorescence of cells in a sample and comparing to a standard value, thereby quantitating total cells in said sample; contacting a sample with a fluorescent dye that is metabolically altered by live cells; said dye having fluorescence properties that are measurably altered when modified by live cells, detecting the metabolic alteration of the dye thereby obtaining a measurement value and comparing said value to a standard value, thereby quantitating live cells in said sample.

Claim 26. A method for measuring the number of total and live yeast, bacteria or other cells in a sample, comprising measuring the native fluorescence of cells in suspension, contacting said cells with a dye that penetrates into the interior of yeast or bacteria and is metabolically modified to a measurable parameter by live cells, measuring the total fluorescence and fluorescence properties provided by the metabolic alteration of said sample and correlating said fluorescence to the number of total and live cells in said sample or a fraction of the sample and determining the percent viability said sample.

Accordingly, Group II which was the group elected by Applicant for continued prosecution as indicated in the Response dated 12/19/2002, which consists of claims 9-24, 27, and 28, is correctly and properly drawn to method of detecting viable cells, while Group I which was the group non-elected by Applicant which consists of claims 1-8, 25, 26, and 29-32, is correctly and properly drawn to device and method of quantitating viable cells and total populations of cells and correlating values therebetween. In addition, Applicant conceded and proceeded with the prosecution of claims 9-24, 27, and 28 in Applicant's response filed 6/30/03, which recite limitations reiterated herein supra, and nowhere in the response acknowledged the alleged error of incorrect description or group of the elected claimed invention. Applicant had full access and knowledge of what is recited in claims 9-24, 27, and 28, and amended the claims by incorporating limitations not encompassed by subject matter of the non-elected group, and did not otherwise question why Group I, encompassing subject matter recited in claims 1-8, 25-26, and 29-32, is not being prosecuted on the merits, if it was indeed Applicant's decision to have elected such subject matter for prosecution.

3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 34-40, as amended, should be withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicant is advised to bring back the claims that were previously under prosecution.

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Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gailene R. Gabel whose telephone number is (571) 272-0820. The examiner can normally be reached on Monday, Tuesday, and Thursday, 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gailene R. Gabel


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Patent Examiner

Art Unit 1641

April 6, 2005 



CHRISTOPHER L. CHIN

PRIMARY EXAMINER

GROUP 1641/1641

4/8/05